

## REMARKS

### Summary

Claims 1-20 were pending and all of the claims were rejected in the Office Action. Claims 1, 4 and 20 have been amended; new Claims 21-30 have been added.

No new matter has been added. The Applicant has carefully considered the references and the reasons for rejection advanced by the Examiner and respectfully traverses the rejections on the basis that a *prima facie* case of obviousness has not been made out.

### Claim Rejections

#### **35 U.S.C §103 (a)**

Claims 1-3, 10, 12-13, 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Itoh et al. (US 5,841,496; "Itoh") in view of Sasaki et al. (US 6,141,073; "Sasaki"), and further in view of Higashi. (US 6,747,719; "Higashi"). The Applicant respectfully traverse the rejection on the basis that a *prima facie* case of obviousness has not been made out.

Amended Claim 1 recites, *inter alia*, an optical diffusion layer deposited on the reflection substrate so as to flatten the surface thereof, wherein the optical diffusion layer is made of a transparent resin or a transparent adhesive having fine particles dispersed therein.

The Examiner acknowledges that Itoh does not teach that the optical diffusion layer has fine particles dispersed therein (Office action, page 4, 3-5<sup>th</sup> lines from bottom of page) and depends on Higashi to remedy this deficiency in the *prima facie* case.

In the Examiner's "Response to Arguments" (Item 8 of the Office action), the Examiner asserts that the term "dispersed" has been interpreted to recite a step of the processing in a device claim, and that this limitation has not been given patentable weight. This is used to justify the use of Higashi even though the layer of particles disclosed by Higashi is acknowledged to be a mono-particle layer. Absent

this determination, the Examiner appears to acknowledge that the structure taught by Higashi is not that of the transparent layer present Claim 1.

The Applicant respectfully traverses the Examiner's conclusion that the term "dispersed", as used in the present claim represents a process of manufacturing (a method) rather than a structural limitation, but even as a process of manufacturing, the limitation must be accorded patentable weight. "It is well established that product claims may include process steps to wholly or partially define the claimed product. See *In re Brown*, 59 CCPA, 459 F.2d 531, 535, 173 USPQ 685, 688 (1972), and the cases cited therein. To the extent these process limitations distinguish the *product* over the prior art, they must be given the same consideration as traditional product characteristics [emphasis in original]." *In re Luck*, 476 F.2d 844, 120 USPQ 523 (CCPA, 1973).

The Applicant respectfully submits that the recitation of Claim 1 that the "optical diffusion layer is made of a transparent resin or a transparent adhesive having fine particles dispersed therein" represents a structural element having a limitation thereto and is fully entitled to patentable weight.

As such, the aspect of Claim 1 where the optical diffusion layer has fine particles dispersed therein is not taught or suggested by Higashi, and the combination of the references applied by the Examiner does not teach or suggest all of the elements and limitations of the present Claim 1, and a *prima facie* case of obviousness has not been made out.

For at least this reason, Claim 1 is not obvious and is allowable. Claims 2-3, 10, 12-13 are claims dependent on an allowable claim and are allowable, without more.

In rejecting Claim 10, the Examiner relies on an aspect of Higashi where the reference discloses synthetic resin particles of a single layer having a diameter range of 1-20 ( $\mu\text{m}$ ) in a binder (col. 6, lines 15-55) and contends that this would inevitably result in a haze of the values recited in Claim 10. However, Hay, cited below, presents experimental data for the Example 2 (see Hay page 8, Chart 2) that demonstrates a haze of greater than 96% for particles having diameters of 3-7 microns, which diameters are with the range taught by Higashi. Thus the Higashi does not result in the haze values of Claim 10. Hence, the Examiner has not made

out a *prima facie* case of obviousness for Claim 10, and other claims such as Claims 2, 8 and 11, where a limitation is found that recites a quantitative haze value.

Claims 4-9, 11, and 14-15 and were rejected under 35 U.S.C. § 103(a) as being unpatentable over Itoh, in view of Sasaki, and Higashi, and further in view of Meyerhofer (US 3,905,682; "Meyerhofer"). Claim 4 recites similar allowable subject matter as Claim 1, and Meyerhofer is not cited to overcome defects in the *prima facie* case set forth above, and thus Claim 4 is allowable. Claims 5-9, 11, 14-15 are claims dependent on an allowable base claim and are allowable, without more.

Claims 18-20 were rejected were rejected under 35 U.S.C. § 103(a) as being unpatentable over Itoh in view of Sasaki, Higashi and Meyerhofer, and further in view of Hay et al. (US 2004/00228141; "Hay"). Hay was published as an application on November 18, 2004, was filed on February 27, 2004 and claims priority to US provisional application 60/451,632, filed on March 3, 2003. The present application was filed in the US on October 2, 2003 and claims priority to Japanese patent application 2002-298596, filed on October 11, 2002. The priority was claimed and acknowledged by the USPTO at the time of filing; and the specification has now been amended to incorporate this priority claim. Hay may thus be excluded as a prior art reference under 35 U.S.C. § 102(e) by perfection of the priority claim of the present application, and the Applicant will do this should the present traverse not be accepted by the Examiner.

In making the obviousness rejection of Claims 18-20, the Applicant respectfully submits that the Examiner has engaged in hindsight. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), cert. denied, 519 U.S. 822 (1996)(citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, Appeal No. 1998-2142 Page 8 Application No. 08/125,189 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

In particular, the Examiner has not explained the reasoning that would permit the application of all of the references to independent Claim 20, and a *prima facie*

case of obviousness has not been made out. The Applicant respectfully submits that the rejection is based on assembling a device using the present claim as a template.

Claim 18 is dependent on Claim 1, and nothing in the application of Hay as a reference is cited to overcome the deficiencies in the *prima facie* case for Claim 1, and thus Claim 18 is allowable as a dependent claim.

Claim 19 is dependent on Claim 4, and nothing in the application of Hay as a reference is cited to overcome the deficiencies in the *prima facie* case for Claim 4, and thus Claim 19 is allowable as a dependent claim

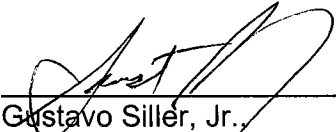
### **Conclusion**

Claims 1- 30 are pending.

For at least the reasons given above, the Applicant respectfully submits that the pending claims are allowable.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,

  
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